

HOL -- 10/797,618

Attorney Docket No.: 081468-308420

- OFFICE ACTION REPLY -

REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the Office Action dated June 23, 2005, the Examiner rejected claims 1-4, 6-15, and 17-21 under 35 U.S.C. §103(a), as being unpatentable over Kamata '319 (U.S. Patent No. 6,084,319) in view of Dombrovski '339 (U.S. Patent Application No. 2003/0030339), and claims 1, 5, 11 and 12 under 35 U.S.C. §103(a), as being unpatentable over Kamata '319 (U.S. Patent No. 6,084,319) in view of Inoue '167 (U.S. Patent Application No. 2003/0048167).

Applicant respectfully traverses the prior art rejections, under 35 U.S.C. §§102(b), 103(a), for the following reasons:

The Examiner asserted that the combination of Kamata '319 and Dombrovski '339 renders the claims invalid. Applicant respectfully disagrees.

Although Kamata '319 discloses the use of cooling plates, it is specifically taught that "the cooling plates of the cooling jacket 52b of the X linear motor 50 are made of an insulating material such as ceramic." (See Kamata '319 at col. 5, line 67 through col. 6, line 2). Kamata '319 elaborates on this point later, stating that "[s]ince, as mentioned above, the cooling jackets 42b and 52b of the Y linear motor 40 and the X linear motor 50, respectively, are composed of an insulating material, the driving efficiency of the Y linear motor 40 and the X linear motor 50 will not be reduced as a result of an increase in the viscous resistance due to eddy currents." (See Kamata '319 at col. 6, lines 24-29). Thus, Kamata '319 specifically teaches away from using cooling elements made of conductive material capable of experiencing eddy currents.

The present invention, in stark contrast to Kamata '319, claims "one or more slits configured to increase electrical resistance of eddy current paths" in each of the application's three independent claims (claims 1, 11, and 12). Instead of teaching or suggesting the use of conductive materials in the cooling elements, Kamata '319 specifically teaches away from this by providing that *only electrically insulating*

HOL - 10/797,618

Attorney Docket No.: 081468-308420

- OFFICE ACTION REPLY -

materials such as ceramic can be used, due to eddy currents. (See Kamata '319 at col. 6, lines 24-29). Thus, Kamata '319 does not even disclose the use of conductive cooling elements, much less "one or more slits configured to increase electrical resistance of eddy current paths" in cooling elements.

In conjunction with the Kamata '319 reference, the Examiner cites Dombrovski '339. (See Office Action at p. 2). However, subsequent to this citation, the Examiner discusses Kamata '319 in conjunction with Ohashi '019 (U.S. Patent No. 6,606,019). Although it is entirely unclear what, if any, concern the Examiner has with the Dombrovski '339 reference, Applicant respectfully notes that there is no disclosure, teaching or suggestion in Dombrovski '339 to employ "slits configured to increase electrical resistance of eddy current paths," as required by each of this application's claims.

To the extent the Examiner intended to use Ohashi '019 in conjunction with Kamata '319, this combination does not render the claims unpatentable. As discussed above, Kamata '319 fails to disclose "slits configured to increase electrical resistance of eddy current paths" and teaches away from the use of conductive materials for cooling elements. Ohashi '019 does not remedy these defects - as there is no teaching or suggestion in Ohashi '019 that discusses the use of conductive cooling elements, much less conductive cooling elements with "slits configured to increase electrical resistance of eddy current paths." In fact, Ohashi '019 specifically limits the use of slits to minimize eddy current flow to usage in *magnets*. (See, e.g., Ohashi '019, col. 3, lines 15-34). Thus, there is nothing in either reference to support the use of cooling elements with "slits configured to increase electrical resistance of eddy current paths." For at least these reasons, the claimed invention is patentable over Kamata '319 in view of Ohashi '019.

The Examiner further asserts that the claimed invention is unpatentable over Kamata '319 in view of Inoue '167. The Examiner directs Applicant's attention to paragraph [0067] of Inoue '167, but there is nothing in this passage, nor in the entirety of Inoue '167, that discloses a cooling element provided with "slits configured to

HOL - 10/797,618

Attorney Docket No.: 081468-308420

- OFFICE ACTION REPLY -

increase electrical resistance of eddy current paths," as required by each of the application's independent claims. Indeed, Inoue '167 suffers from the same defect as Ohashi '019: the use of slits is limited to uses in magnets and nothing in either reference discloses, teaches or suggests the use of cooling elements with "slits configured to increase electrical resistance of eddy current paths." Because of this failing, and due to Kamata '319 specifically teaching away from using a conductive material as a cooling element, the asserted combinations do not render the claimed invention unpatentable. Accordingly, the independent claims of the claimed invention are not subject to rejection under § 103(a) as the Examiner asserted, and are in condition for allowance.

In addition, dependent claims 2-10 and 13-21 are allowable at least by virtue of their dependence on the independent claims as well as for their additional limitations. Accordingly, these claims are not subject to rejection under § 103(a) as the Examiner asserted, and are also in condition for allowance.

III. Conclusion.

All matters having been addressed, Applicant respectfully requests the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

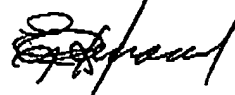
Applicant's Counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. Please charge any fees associated with the submission of this paper to Deposit Account Number 033975, Order No. 081468-0308420.

HOL - 10/797,618**Attorney Docket No.: 081468-308420****- OFFICE ACTION REPLY -**

The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

**PILLSBURY WINTHROP
SHAW PITTMAN LLP**



E. RICO HERNANDEZ
Reg. No. 47641
Tel. No. (703) 905-2088
Fax No. (703) 905-2500

Date: September 13, 2005
ERH/dlh
P.O. Box 10500
McLean, VA 22102
(703) 905-2000